

**REMARKS****Response to Claim Rejections Under 35 U.S.C. §103**

Claims 1, 40-43 and 47-53 were rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Kieturakis U.S. Pat. No. 5,794,626) in view of Tihon et al. (U.S. Pat. No. 5,415,656) and further in view of Burbank et al. (U.S. Pat. 5,526,822).

Claims 44-45 were rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Kieturakis ('626) in view of Tihon et al. ('656) Burbank et al. ('822), and further in view of Treat (U.S. Pat. No. 4,493,320).

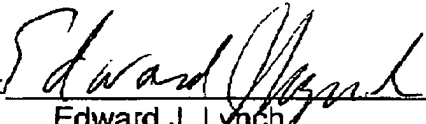
The Examiner contends that it would be obvious to combine the teachings of Tihon with the teachings of Kieturakis in order to make the cutting operation easier. However, the cutting mechanism of Tihon would not be functional with respect to Kieturakis. Specifically, the Tiho device is designed for transurethral incision of the prostate. No tissue is removed in the procedure. A longitudinal incision is made in the patient's urethral canal to eliminate blockage due to benign prostate hyperplasia. There is no lateral or rotational motion of the electrosurgical electrode in the Tihon device, so there is no teaching that would lead those skilled in the art to believe that the electrode of the Tihon device would make tissue removal of a patient's breast by lateral or rotational movement easier than the Kieturakis device. Importantly, the device described by Kieturakis is not designed to sever an entire specimen that surrounds the distal end of the device, but instead severs small pieces of tissue which are aspirated through ports (55) to be removed from the site which is the only mode of tissue removal described.

The Tihon patent makes reference in the Background of the Invention of transurethral resection of the prostate (TURP) which relates to removal of prostate tissue to ameliorate the effects of an enlarged prostate, i.e. benign prostate hyperplasia. If it was obvious to use the device described in the Tihon patent for lateral or rotational movement to remove prostate tissue, surely the inventors would have mentioned it. But they did not. Therefore, the combination of these references fails to teach the features of claim 1 and those claims which depend from claim 1, particularly as amended above.

### Conclusion

Applicants believe that the pending claims are directed to patentable subject matter. Reconsideration and an early allowance are earnestly solicited.

Respectfully submitted,

By:   
Edward J. Lynch  
Registration No. 24,422  
Attorney for Applicants

EDWARD J. LYNCH  
Patent Attorney  
One Embarcadero Center  
Suite 562  
San Francisco, CA 94111  
Telephone: (415) 646.8028  
Facsimile: (415) 646.8035